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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,098	02/17/2004	David J. Allard	BOC9-2003-0087 (458)	9891
40/987 7590 12/30/2008 AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188				
EXAMINER				
RANGREU, SHEETAL				
ART UNIT		PAPER NUMBER		
3686				
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12/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/780,098

**Applicant(s)**

ALLARD ET AL.

**Examiner**

SHEETAL R. RANGREJ

**Art Unit**

3686

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 16-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Prosecution History Summary*

1. Claims 5-15 and 19 are cancelled.
2. Claims 1-4 and 16-18 are pending.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker (6,988,075; hereinafter Hacker) in view of Kenneth D Mandl, Peter Szolovits, Isaac S Kohane, David Markwell, and Rhona MacDonald **Public standards and patients' control: how to keep electronic medical records accessible but private • Commentary: Open approaches to electronic patient records • Commentary: A patient's viewpoint** BMJ, Feb 2001; 322: 283 – 287 (herein after Mandl).

5. As per claim 1, Hacker discloses a method of permitting controlled access to medical information comprising:

(1) establishing a storage means for storing the medical information of the patient  
(**Hacker: col. 7, lines 21-27**);

(2) establishing a means for accessing the medical information by the patient or any other authorized user (**Hacker: col. 7, lines 56-66**).

(3) assigning each user with a unique ID (**Hacker: col. 7, 43-50**) and pin (**Hacker: col. 7, 43-50; i.e. alphanumeric passphrases; col. 7, 60-66**) and tracking and notifying the patient of who accessed the medical information, what was accessed, and when was access taken place (**Hacker: col. 7, 66-col. 8, 3**). Although Hacker does not explicitly teach who accessed the medical information, it is obvious that who accessed the medical information is a pertinent information and the prior art suggests providing the information of who accessed the medical information.

Hacker does not explicitly teach controlling an authorization and a scope of access to the medical information by the patient according to an assigned role of a user accessing the medical information, by modifying an access control list; and wherein the access control list lists each authorized user and the assigned role of each authorized user.

Mandl teaches:

(3) controlling an authorization and a scope of access to the medical information by the patient according to an assigned role of a user accessing the medical information, by modifying an access control list (**Mandl: p. 284, section Confidentiality**).

Wherein the access control list lists each authorized user and the assigned role of each authorized user (**Mandl: p. 284, section Confidentiality**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings with the motivation of providing a user with managing their own health record and providing a user with a secure data repository of their own medical record (Mandl).

6. As per claim 2, Hacker discloses the method of claim 1, wherein the storage means is a central repository (**Hacker: col. 7, lines 21-27**).

7. As per claim 3, Hacker discloses the method of claim 1, wherein the means for accessing the medical information is controlled using a universally unique identifier (**Hacker: col. 7, lines 42-63**).

8. As per claim 4, Hacker discloses the method of claim 1, wherein said controlling step is overridden by a registered emergency provider (**Hacker: col. 7, lines 66-67**).

9. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hacker (6,988,075; hereinafter Hacker) in view of Kenneth D Mandl, Peter Szolovits, Isaac S Kohane, David Markwell, and Rhona MacDonald and further in view of Felsher (2002/0010679; hereinafter Felsher).

10. As per claim 16, Hacker and Mandl disclose the method of claim 1, but do not teach wherein the patient is compensated for permitting some of the medical information to be available and used by a research institution.

Felsher teaches wherein the patient is compensated for permitting some of the medical information to be available and used by a research institution (**Felsher: para. 310**).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings with the motivation of providing a medical history that may be of

critical importance to the future of healthcare (**Felsher: para. 7**) and the need for privacy and security of a patient's information (**Felsher: para. 17**).

11. As per claim 17, Hacker and Mandl disclose the method of claim 1, but do not teach wherein during a doctor visit the patient provides access to the medical information for a time period long enough to support the visit at which point the access times out.

Felsher teaches wherein during a doctor visit the patient provides access to the medical information for a time period long enough to support the visit at which point the access times out (**Felsher: para. 354**).

The motivation to combine the teachings is the same as claim 16.

12. As per claim 18, Hacker and Snowden disclose the method of claim 1, but do not teach wherein access to the patient's medical information expires when a physician logs into another room/appointment.

Felsher teaches wherein access to the patient's medical information expires when a physician logs into another room/appointment (**Felsher: para. 359; i.e. second communication session**).

The motivation to combine the teachings is the same as claim 16.

### ***Response to Arguments***

13. Applicant's arguments filed for claims 1-4 and 16-18 have been fully considered but they are not persuasive.

14. Applicant argues that Hacker does not suggest anything unique to the provider, but instead a code used in conjunction with the patient bar code or card to access patient sensitive information; therefore, Hacker does not disclose assigning each user with a unique ID and pin as recited in claim 1. In response to Applicant's argument, **Examiner disagrees**. Hacker teaches providing the provider with appropriate means for input of the unique access identification for patient identification and access along with unique passphrases (i.e. pin) to access the patient information (Hacker: col. 7, 60-66). Furthermore, claim limitations do not teach or suggest that a user is a "provider" and that the unique ID and pin of a user are unique to a provider.

15. Applicant argues that Mandl does not suggest using an access control list as the mechanism for controlling access. In response to Applicant's argument, **Examiner disagrees**. Mandl discloses the patient having preferences about different parts of his/her medical history by providing authorization independently; furthermore teachings that patients grant different access rights to different providers based on their role and on the particular individual (Mandl: p. 284; section Confidentiality). According to the Applicant's specification, an example of an access control list could be providing access to parties based upon their assigned role (para. 23).

16. Regarding claim 3, Applicant argues that Hacker does not teach a "universally unique identifier," rather teaches an identifier that could be specific only to a particular record system. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an identifier that could be specific only to a particular record system) are not recited in the rejected claim(s). Although the

claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. Regarding claim 4, Applicant argues that Hacker does not teach the mechanism of registration of emergency providers that would prevent the access to information by those searching for private information and posing to be an emergency provider. Examiner states that Hacker discloses an emergency override of the medical records' security to the medical information and providing notification to the patient of what information was release, including time, location, pages accessed, etc. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., prevent the access to information by those searching for private information and posing to be an emergency provider) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

18. Regarding claim 17, Applicant argues that Felsher does not teach "wherein during a doctor visit the patient provides access to the medical information for a time period long enough to support the visit at which point the access times out." Examiner disagrees and provides support in the cited portions for Felsher. Applicant further states that the mechanism of logging into another examining room should immediately prevent access from a prior terminal. In

response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., mechanism of logging into another examining room should immediately prevent access from a prior terminal) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

19. Regarding arguments in Office Action dated 08/07/2008, Applicant argues that Hacker does not teach the identification or means of identification of an individual accessing private information, and therefore would be unable to provide an accounting as such. Applicant provides a mere conclusory statement regarding Hacker unable to teach "tracking and notifying the patient of who accessed the medical information, what was accessed, and when was access taken place;" therefore, Examiner maintains the cited portion of Hacker to teach "tracking and notifying the patient of who accessed the medical information, what was accessed, and when was access taken place."

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHEETAL R. RANGREJ whose telephone number is (571) 270-1368. The examiner can normally be reached on M-F 8:30-5:30.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

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